



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/319,142 07/29/99 WINTER E 45/235LI/SC

IM52/1222
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TIJERAS NM 87059

EXAMINER

CHEVALIER, A

ART UNIT

PAPER NUMBER

1772

10

DATE MAILED:

12/22/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/319,142

Applicant(s)

WINTER ET AL.

Examiner

Alicia Chevalier

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2000.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 16-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

RESPONSE TO AMENDMENT

WITHDRAWN REJECTIONS

1. The 35 U.S.C. §112 rejection of claim 21 of record in paper #8, page 2, paragraph #3 has been withdrawn due to Applicant's amendment in paper #9.

REJECTIONS REPEATED

2. The 35 U.S.C. §112 rejection of claim 20 is repeated for reasons previously of record in paper #8, page 2, paragraph #2.
3. The 35 U.S.C. §112 rejection of claim 25 is repeated for reasons previously of record in paper #8, pages 2-3, paragraph #4.
4. The 35 U.S.C. §112 rejection of claim 26 is repeated for reasons previously of record in paper #8, page 3, paragraph #5.
5. The 35 U.S.C. §112 rejection of claim 26 is repeated for reasons previously of record in paper #8, page 3, paragraph #6.
6. The 35 U.S.C. §103 rejection of claims 16-18, 20, 22-27, and 29-31 over Nassau (5,882,786) in view of Gregory (2,521,846) is repeated for reasons previously of record in paper #8, pages 4-7, paragraph #8.
7. The 35 U.S.C. §103 rejection of claims 19, 21, and 28 over Nassau (5,882,786) in view of Gregory (2,521,846) and in further view of Lampert (5,431,028) is repeated for reasons previously of record in paper #8, pages 7-8, paragraph #9.

ANSWERS TO APPLICANT'S ARGUMENTS

8. Applicant's arguments filed in paper #9 regarding the 35 U.S.C. §112 rejection of claim 21 of record has been considered but are moot since the rejections have been withdrawn.

9. Applicant's arguments filed in paper #9 regarding the 35 U.S.C. §112 rejection of claim 20 of record have been carefully considered but are deemed unpersuasive.

Applicant argues that the term "hard metals" is a term of art in the relevant technical area, and that claim 20 needs no further classification. The Examiner disagrees with this position and still considers the term unclear. It is unclear what types of metal are considered hard. Comparatively speaking is "hard" on the range of gold or titanium.

10. Applicant's arguments filed in paper #9 regarding the 35 U.S.C. §112 rejections of claim 25 and 26 of record have been carefully considered but are deemed unpersuasive.

While Applicant has now provided antecedent basis for the limitation "the pyramid angle," the limitation is still unclear. Neither the specification nor the claim language defines what a "pyramid angle" is, i.e. is the angle created between the depression and the substrate, is the angle between the depression and normal to the substrate, etc.

11. Applicant's arguments filed in paper #9 regarding the Nassau reference of record have been carefully considered but are deemed unpersuasive.

Applicant argues that the diamond layer of Nassau imparts no decorative characteristics to the silicon carbide gemstone and these characteristics are the result of grinding or polishing the silicon carbide stone.

First, process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the

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prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). This burden is NOT discharged solely because the product was derived from a process not known to the prior art. *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113.

Secondly, the fact that the diamond layer does not impart a decorative characteristic to the silicon carbide gemstone is irrelevant since there is no limitation in the claims that states the support layer gives the stone layer a decorative characteristic. It is the claims that define the claimed invention, and it is claims, not specifications that are anticipated or unpatentable. *Constant v. Advanced Micro-Devices Inc.*, 7 USPQ2d 1064.

12. Applicant's arguments filed in paper #9 regarding the Gregory reference of record have been carefully considered but are deemed unpersuasive.

The Examiner is uncertain what argument Applicant is trying to make regarding the Gregory reference. As stated above the method of forming the product is not germane to the issue of patentability of the product itself. Also, Gregory is used to teaches imparting gem-like or jewel-like properties with a support having at least one pyramid-shaped depression..

13. Applicant's arguments filed in paper #9 regarding the Lampert reference of record have been carefully considered but are deemed unpersuasive.

Once again the Examiner is uncertain the argument Applicant is trying to make regarding the Lampert reference. The Lampert reference is used to teach a support comprised of precious metal and the pyramid shaped depressions have mirror surfaces.

14. Applicant's arguments filed in paper #9 regarding the unexpected and surprising results of record have been carefully considered but are deemed unpersuasive.

As stated above with regard to product-by-process claims, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present *evidence* from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. In view of the lack of evidence, the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.

Also, the limitation in that with a thin surface-shaped synthetic gemstone layer, superior light-reflecting qualities are not in the claims. It is the claims that define the claimed invention, and it is claims, not specifications that are anticipated or unpatentable. *Constant v. Advanced Micro-Devices Inc.*, 7 USPQ2d 1064.

Conclusion

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (703) 305-1139. The Examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:00 p.m. The Examiner can also be reached on alternate Fridays

If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Ellis P. Robinson can be reached by dialing (703) 308-2364. The fax phone number for the organization official non-final papers is (703) 305-5436. The fax number for after final papers is (703) 305-3599.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose phone number is (703) 308-0661.

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12/20/00


Ellis Robinson
Supervisory Patent Examiner
Technology Center 1700